

REMARKS/ARGUMENTSAmendments to the Claims

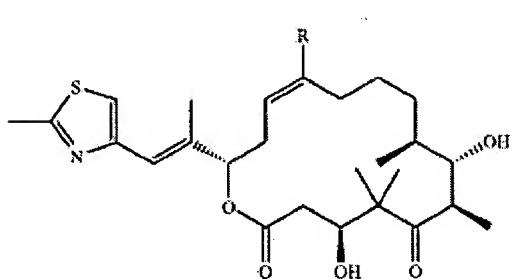
Claims 5, 14, and 19-20 are amended. Claims 1-4, 7-13, and 15-18 are cancelled, without prejudice against the presentation of their subject matter in a continuing application. Claims 5-6, 14, and 19-20 remain in the application.

The claims have been amended to specify that the first drug is epothilone D and the second drug is rapamycin or a rapamycin analog.

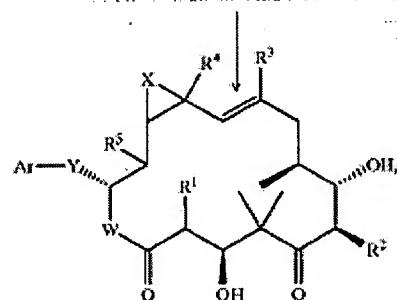
Rejection under 35 USC §102(e) over US 2003/0045711 ("Ashley")

The rejection of claims 1-3 under §102(e) over Ashley is traversed.

Firstly, compounds disclosed by Ashley are generically epothilones, but are different from epothilone D in that they possess a double bond at the 10,11 position (see arrow), which double bond is absent in epothilone D.¹ Therefore, Ashley does not anticipate the claims as amended.



Epothilone D (R = CH₃)



Ashley

Secondly, Applicants claim the benefit of the provisions 35 USC §103(c)(1), which reads as follows:

¹ These compounds are not made from epothilone D, so it is not accurate to characterize them as "derivatives of epothilone D."

Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person.

The undersigned attorney affirms that, at the time the present invention was made, the instant application and Ashley were subject to an obligation to assign to, or were owned by, Kosan Biosciences. The assignment of the instant application in favor of Kosan Biosciences was recorded on Aug. 23, 2004, at Reel/Frame Nos. 015707/0321. The assignment of Ashley in favor of Kosan Biosciences was recorded on Jul. 8, 2002, at Reel/Frame Nos. 013070/0665.

Therefore, Ashley is not citable as a reference under §102(e)/103.

In view of the foregoing, reconsideration and withdrawal of the rejection over Ashley is respectfully requested.

Rejection under 35 USC §102(e) over US 2003/0114450 A1 ("Santi")

The rejection of claims 1-6 under §102(e) over Santi is traversed. Santi does not disclose the subject matter of the amended claims, namely an epothilone D/rapamycin or rapamycin analog combination for preventing restenosis.

Further, Applicants also rely on 35 USC §103(c)(1) in the event the Examiner should wish to consider a §102(e)/103 rejection.

The undersigned attorney affirms that, at the time the present invention was made, the instant application and Santi were subject to an obligation to assign to, or were owned by, Kosan Biosciences. The assignment of the instant application in favor of Kosan Biosciences was recorded on Aug. 23, 2004, at Reel/Frame Nos. 015707/0321. The assignment of Santi in favor of Kosan Biosciences was recorded on Oct. 31, 2002, at Reel/Frame Nos. 013448/0523.

In view of the foregoing, reconsideration and withdrawal of the rejection over Santi is respectfully requested.

Rejection under 35 USC §103(a) over Ashley in view of US 2002/0127263 ("Carlyle")

The rejection of the amended claims over Ashley in view of Carlyle is traversed. For the reason given above, Ashley is not citable as a reference under §103 against the instant application.

Reconsideration and withdrawal of the rejection is respectfully requested.

Miscellaneous

The Commissioner is authorized to charge against Deposit Account No. 50-2544 the fee under for three months' extension of time and any other fees that might be necessary under 37 C.F.R. §§1.16, 1.17, or 1.18, and to credit any overpayments to the same account. A fee sheet confirming such authorization is enclosed.

Conclusion

In conclusion, it is submitted that this application is in condition for allowance. A prompt and favorable action is earnestly solicited.

Respectfully submitted,

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Date


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